

Serial No. 09/714,702  
Attorney Docket No. 65678-0037 (5397 DCCSP)

## REMARKS

### **I. INTRODUCTION**

Claims 1-25 are pending. In the Office Action: (1) claims 1-4, 8-11, 16-18, and 21-14 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,875,430 ("Koether"); (2) claims 5-7 and 25 were rejected under 35 U.S.C. 103(a) as being obvious over Koether; and (3) claims 12-15, 19, and 20 were rejected under 35 U.S.C. 103(a) as being obvious over Koether in view of U.S. Patent No. 5,900,801 ("Heagle") and U.S. Patent No. 6,417,760 ("Mabuchi").

Applicants respectfully traverse the rejections in light of the admonitions by the Federal Circuit Court of Appeals in In re Thrift, Case Number 01-1445 (Fed. Cir. August 9, 2002) against rejections based on a "very general and broad conclusion" when "cited references do not support each limitation" in a claim. In Thrift, the Federal Circuit found that:

While the examiner's statement generally addresses the use of grammar, it does not discuss the unique limitations of extracting, modifying, or processing the grammar to interact with hypermedia sources. The Board's decision is not supported by substantial evidence because the cited references **do not support each limitation** of claim 11. See In re Vaack, 947 F.2d 488, 493, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991) [emphasis added].

The references cited by the Examiner fail, in the aggregate, to disclose all of the elements and functionality in the Applicants' claims. For example, the Examiner admits "that Koether doesn't explicitly recite receiving foundational data prior to the acquired data" much less the "forms used to collect foundational data" (Office Action, page 6).

Applicants believe that claims 1-25 are in condition for allowance, and respectfully traverse the Examiner's rejections. Regarding the Section 102 rejections, Koether does not disclose each and every element of the claimed invention. Regarding the Section 103 rejections, the cited references also fail to disclose each and every element of the claimed invention. Furthermore, the cited references do not affirmatively suggest their combination. With respect to claim elements not disclosed in the cited art, patent examiners may not "rely on conclusory statements when dealing with particular combinations of prior art and specific claims." In re Sang Su Lee, 2002 U.S. App. LEXIS 855, at \*17-18 (Fed. Cir. January 18, 2002). Contrary to the Examiner's assertions, the cited references teach away from each other and any combination resembling Applicants' claims.

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In the Office Action mailed on March 11, 2003, the Examiner rejected claims 1-20 (claims 21-25 were added subsequently) on the same grounds as in the Office Action mailed October 22, 2003, to which the present Remarks are responsive. In Remarks accompanying the Request for Continuing Examination filed August 11, 2003 (the "Prior Remarks"), Applicants traversed the Examiner's rejection of claims 1-20 in the Office Action mailed on March 11, 2003, and advanced numerous arguments in support of claims 1-25 (*see* Prior Remarks, pages 10-21). The Examiner did not respond to any of Applicants' arguments in the Office Action. Claims 1-25 are patentable for the reasons given in the Prior Remarks, and pages 10-21 of the Prior Remarks are accordingly fully incorporated herein by reference. Applicants respectfully request that the Examiner reconsider these arguments and, in the event they are believed unpersuasive, provide appropriate responses thereto. Additional reasons for the patentability of claims 1-25 are given below.

## II. REJECTIONS UNDER 35 U.S.C. § 102(e)

Independent claims 1, 16, and 18 were rejected under 35 U.S.C. 102(e) as being anticipated by Koether. As amended, claims 1, 16, and 18 include the functionality of generating "a preventative maintenance determination from said acquired data and at least one historical characteristic relating to said asset." As noted in the Prior Remarks, none of the cited prior art references teach this claim limitation. The Examiner (Office Action, pages 4-5) states that Koether teaches the recited "preventative maintenance determination". While the portion of Koether cited by the Examiner does teach a "control center" that "analyzes . . . diagnostic information" (Koether, col. 9, lines 44-45), Koether contains absolutely no teaching or suggestion of "generating a preventative maintenance determination". In fact, Koether teaches against this claim limitation because Koether teaches analyzing the diagnostic information to determine "whether to disable the appliance . . . or . . . to modify the cooking profiles stored in the appliance." That is, Koether teaches taking steps that would be unnecessary if a preventative maintenance determination had been generated. Moreover, Applicants respectfully note that, inasmuch as claims 1, 16 and 18 have been rejected under 35 U.S.C. § 102, Koether's failure to teach each and every limitation of the claims, in particular, "generating a preventative maintenance determination", renders the claims patentable over Koether.

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Therefore, claims 1, 16, 18, and all of their dependent claims (claims 2-15, 17, 19-25) are in condition for allowance.

### III. REJECTIONS UNDER 35 U.S.C. 103(a)

In addition to the arguments incorporated from the Prior Remarks regarding the Examiner's claim rejections under Section 103, Applicants respectfully point out that the Examiner has failed to make a *prima facie* case of obviousness because the Office Action fails to state a motivation to modify or combine the cited references with the specificity required by the Federal Circuit Court of Appeals in In re Thrift, Case Number 01-1445 (Fed. Cir. August 9, 2002) and in In re Sang Su Lee, 2002 U.S. App. LEXIS 855, at \*17-18 (Fed. Cir. January 18, 2002). Because the prior art does not disclose the particular structural and relational elements included in Applicants' claims, Applicants respectfully repeat the request they made in the Prior Remarks for any assertion of obviousness to be supported with an actual reference or a duly executed affidavit pursuant to MPEP § 2144.03.

Specific instances in which the Office Action does not meet the burden of stating the required motivation to combine or modify references, much less support that statement with a prior art reference or affidavit, as required by the MPEP, are as follows.

The Office Action states on page 6 (rejecting claims 5-7) that

Koether doesn't explicitly recite receiving foundational data prior to acquired data. However, it would have been obvious to one of ordinary skill to collect foundational data prior to acquired data, if there were similar repairs, or installation problems at another location, which can be used to resolve the situation at the current site. The hand-held device of the Koether system contains forms [citation omitted]. But, Koether, doesn't explicitly recite forms used to collect foundational data. Nonetheless, forms are a well known processing tool used for presenting and/or receiving data in a structured manner. Therefore, it would have been obvious to one of ordinary skill to utilize forms for querying the maintenance database [citation omitted].

Applicants respectfully submit that the Examiner should provide support in the prior art for the assertion that "it would have been obvious to one of ordinary skill to collect foundational data prior to acquired data, if there were similar repairs, or installation problems at another location, which can be used to resolve the situation at the current site." Further, Applicants submit that the Examiner must provide support for the statement that "forms are a well known processing

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tool used for presenting and/or receiving data in a structured manner" as well as a motivation, with support, for one of ordinary skill in the art to have modified Koether to use forms as proposed by the Examiner.

The Office Action states on pages 6-7 (rejecting claim 25) that

[T]he specific data identified by Koether et al (column 9, lines 10-45) is not necessary and sufficient for implementing their system as Koether et al. explicitly recite "may include" referring to the type of data being collected. Therefore it would have been obvious to one of ordinary skill to collect whatever data necessary in order to provide the an [sic] accurate analysis of the monitored appliances.

Applicants respectfully submit that the Examiner should provide a motivation, with support, for one of ordinary skill in the art to have modified Koether "to collect whatever data necessary in order to provide the an [sic] accurate analysis of the monitored appliances."

The Office Action states on pages 7-8 (rejecting claims 12-15, 19, and 20) that

Koether does not explicitly recite user training. Heagle et al. teach a system for monitoring conditions at a food service establishment, utilizing a local or analysis controller (figure 1) comprising: user identification and access authorization that includes an analysis of user training [citations omitted]. However, neither Heagle et al. nor Koether explicitly recite receiving user ID data, transmitting the ID data to a remote database to derive access to equipment. Mabuchi et al. teach a maintenance and inspection system that maintains worker files, including identification, authorization, and certification data, in order to determine whether a worker is allowed to operate equipment [citations omitted]. Therefore, it would have been obvious to one of ordinary skill to combine the systems of Koether, Heagle et al., and Mabuchi et al. in order to maintain a clean and efficiently operating environment where food is prepared and/or distributed . . .

Applicants respectfully submit that the Examiner must provide a motivation, with support, for one of ordinary skill in the art to have performed the combination of Koether, Heagle, and Mabuchi proposed by the Examiner.

#### IV. LEGAL AUTHORITY CITED IN THE REJECTION OF CLAIM 25

Claim 25 recites that "said historical characteristic and said remote historical characteristic are not dates on which maintenance were performed." In rejecting claim 25, the Examiner asserts that Koether teaches a system that collects data, and asserts that claim 25 recites "non-functional data as it does not alter how the machine functions." (Office Action,

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pages 6-7). In support of the Examiner's position, the Office Action cites *In re Gulack*, 703 F.2d 1381, 1382, 217 USPQ 401 (Fed. Cir. 1983), for the proposition that "nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious." (Office Action, page 7.)

While Applicants disagree with the Examiner's characterization of claim 25 as reciting "non-functional" data, they also wish to point out that the case law, including *Gulack*, in fact supports the position directly contrary to that taken by the Examiner. *Gulack* was a case in which the court held that printed matter on a substrate *should* be given patentable weight. *Gulack*, 703 F.2d at 1387. Moreover, following *Gulack* the Federal Circuit has made clear that such cases are irrelevant in situations in which information was to be processed by a computer rather than the human mind. *In re Lowry*, 32 F.2d 1579, 1580, 32 USPQ,2d 1031 (Fed Cir. 1994) (quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969)). Beyond establishing that the Federal Circuit has a liberal view of what subject matter qualifies as functional, the *Lowry* court further explained that part of establishing a prima facie case of obviousness was that "the burden of establishing the absence of a novel, nonobvious, functional relationship rests with the PTO." *Lowry*, 32 F.3d at 1584.

Here, the Examiner has clearly not met the requisite burden mandated by *Lowry*. The examiner has simply asserted that claim 25 recites collecting "non-functional" data and that "the system is monitored whether or not the data comprises the date on which maintenance was performed or not." (Office Action, page 7.) Claim 25 is accordingly patentable for this independent reason.

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**CONCLUSION**

As amended, claims 1-25 are in condition for allowance. It is believed that no fees are due with respect to this paper. However, if any fees are found to be required in connection with the filing of this paper, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

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